

Application No.: 10/522,225

Docket No.: ASZD-P01-804

Furthermore, the standard for unity of invention does not account for burden on the Examiner. Although the requested division of the term "heterocyclyl" is not the same as restriction between different members of a Markush group, restriction of members within a broad term should certainly be treated no more harshly. Unity of invention within Markush groups is discussed at MPEP 1850. In particular,

When Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; and

(B)(1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or (B)(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

Applicants assert that criterion (A) is satisfied, namely that the compounds of Groups IX-XXVIII possess a common property in their biological activity, that is, the common property of inhibiting 11- β -hydroxysteroid dehydrogenase type 1. Even if the various encompassed heterocycles do not meet criterion (B)(1), alternative criterion (B)(2) clearly applies – all of the substituents at issue are heterocycles, an art-recognized class of moieties. Applicants assert that criterion (B)(2) is satisfied in that all compounds of Groups IX-XXVIII and other groups not explicitly designated belong to a recognized class of chemical compounds in the art to which the invention pertains. Consideration of the burden on the examiner is conspicuously absent from MPEP 1850. As such, Applicants assert that the moieties encompassed by the term "heterocyclyl" have a technical interrelationship and the required same or corresponding special technical features as defined in PCT Rule 13.2 so as to possess unity of invention (MPEP 1850). Thus, Applicants assert that Groups IX-XXVIII possess unity of invention and that the restriction requirement of record is improper.

Moreover, according to MPEP 1850, "it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority." Applicants respectfully point out that here the International Preliminary Examining Authority found no lack of unity in the International

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Search Report. The apparent disregard for the IPEA's finding of unity is further evidence that the restriction requirement is improper.

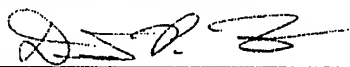
Applicants respectfully request that, if restriction is to be maintained in the face of the IPEA's finding of unity, the restriction be amended to unite Groups IX-XXVIII, and relegate the division between different heterocycles to an election of species.

In response to the requirement that Applicants elect a single disclosed species, Applicants elect Example 51, (piperidin-1-ylsulphonyl methyl)-(4-fluorophenyl)-ketone, for search purposes only.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Attached herewith is a four-month petition for extension of time with authorization of the required fee. Applicant believes no further fees are due with this response. However, if any further fees are due, please charge our Deposit Account No. 18-1945, under Order No. ASZD-P01-804 from which the undersigned is authorized to draw.

Dated: August 8, 2007

Respectfully submitted,

By 

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